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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER KURTZ, BENJAMIN M	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/552,631

**Applicant(s)**

TRYGGVASON ET AL.

**Examiner**

BENJAMIN KURTZ

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.  
4a) Of the above claim(s) 26-35 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-25 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 11/05, 11/05, 12/06  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 26-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 7/28/08. Applicant argued groups I, II and III have unity of invention because they contain the same special technical feature, the filter of claim 1. The filter of Kahana anticipates the device of claim 1; therefore the technical feature common to all groups is not a special technical feature. The limitation in claim 1 of the device for use in a cartridge for preparing a liquid for medical procedure is a recitation of intended use and does not add any structural limitations to the device.

### **Double Patenting**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17, 23-38 and 44-60 of copending Application No. 10/552629. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application contains the same subject matter of a filter having slit like openings therein being included in a filter cartridge.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Specification***

4. The disclosure is objected to because of the following informalities: Pages 8, 9 and 10 of the specification make reference to specific claim number. Claim number may change during prosecution.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites the limitation "said slit shaped openings". There is insufficient antecedent basis for this limitation in the claim. For examination purposes 'said slit shaped openings are assumed to be 'said at least one slit shaped opening'.

Claims 15-20 are rejected as containing the same defects of claim 14.

***Claim Rejections - 35 USC § 102 and 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**6. Claims 1-3, 6, 12-16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Kahana US 5 637 214.**

Claim 1, Kahana teaches a device comprising: a hollow body defined by a wall (56, 58, 62) enclosing a cavity of the body, the body having a first end and a second end and being provided with at least one slit shaped opening (64) extending through the wall, the first end being open, the slit shaped opening has a first extension and a second extension being substantially perpendicular to a flow direction and to the first extension, wherein the second extension is significantly shorter than the first extension (fig. 2).

Claims 2, 3, 6, 12-16 and 19, Kahana further teaches the hollow body has a center axis and an elongated, tubular shape along the center axis (fig. 2); the hollow body is tapering along the center axis towards the second end (fig. 2); the first extension is substantially perpendicular to a flow direction (fig. 2); a plurality of slit shaped openings which extend through the wall (fig. 2); the slit shaped openings are distributed around the wall (fig. 2); the hollow body has a wall portion at least in the proximity of the second end and wherein the slit shaped opening extends through the wall portion (fig. 2); the wall portion has a tip like shape (fig. 2); the wall portion is substantially conical (fig. 2); and the flow direction forms an angle to the center axis (fig. 2).

**7. Claims 1-3, 6, 12-16, 19 and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Barlow US 6 776 907.**

Claim 1, Barlow teaches a device (38) comprising: a hollow body defined by a wall enclosing a cavity of the body, the body having a first end and a second end and

being provided with at least one slit shaped opening (40) extending through the wall, the first end being open, the slit shaped opening has a first extension and a second extension being substantially perpendicular to a flow direction and to the first extension, wherein the second extension is significantly shorter than the first extension (fig. 4).

Claims 2, 3, 6, 12-16 and 19, Barlow further teaches the hollow body has a center axis and an elongated, tubular shape along the center axis (fig. 4); the hollow body is tapering along the center axis towards the second end (fig. 4); the first extension is substantially perpendicular to a flow direction (fig. 4); a plurality of slit shaped openings which extend through the wall (fig. 4); the slit shaped openings are distributed around the wall (fig. 4); the hollow body has a wall portion at least in the proximity of the second end and wherein the slit shaped opening extends through the wall portion (fig. 4); the wall portion has a tip like shape (fig. 4); the wall portion is substantially conical (fig. 4); and the flow direction forms an angle to the center axis (fig. 4).

Claims 22 and 23, Barlow teaches a cartridge (10) including: an inner space, an inlet (28) to permit introduction of fluid into the inner space, an outlet (18) to permit discharge of fluid from the inner space, a device (38) comprising a hollow body defined by a wall enclosing a cavity of the body, the body having a first end and a second end and being provided with at least one slit shaped opening (40) extending through the wall, the first end being mounted to the cartridge and at the inlet such that the body extends into the inner space and the second end is located in the inner space of the cartridge, the first end being open, the slit shaped opening has a first extension and a second extension being substantially perpendicular to a flow direction and to the first

extension and the second extension is significantly shorter than the first extension (fig. 3, 4). The recitation of the cartridge being for preparing a liquid solution for a medical procedure and arranged to contain a particulate material is a recitation of intended use and does not further structurally limit the apparatus.

Claims 24 and 25, Barlow further teaches the cartridge includes a filter (22) arranged at the outlet permitting fluid flow through the filter in a filter direction (fig. 5); and the filter includes at least one slit shaped opening (20) which has a first extension and a second extension being substantially perpendicular to the filter direction and to the first extension, wherein the second extension is significantly shorter than the first extension (fig. 5).

**8. Claims 1, 2, 6, 12-15 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Weber US 3 155 612.**

Claim 1, Weber teaches a device (7) comprising: a hollow body defined by a wall enclosing a cavity of the body, the body having a first end and a second end and being provided with at least one slit shaped opening (8, 12) extending through the wall, the first end being open, the slit shaped opening has a first extension and a second extension being substantially perpendicular to a flow direction and to the first extension, wherein the second extension is significantly shorter than the first extension (fig. 3).

Claim 2, 6, 12-15, 17-20, Weber further teaches the hollow body has a center axis and an elongated, tubular shape along the center axis (fig. 3); the first extension is



substantially perpendicular to a flow direction (fig. 3); a plurality of slit shaped openings which extend through the wall (fig. 3); the slit shaped openings are distributed around the wall (fig. 3); the hollow body has a wall portion (11) at least in the proximity of the second end and wherein the slit shaped opening extends through the wall portion (fig. 3); the wall portion has a tip like shape (fig. 3); the wall portion is substantially plane (fig. 3); a normal direction of the wall portion forms an angle of inclination to the center axis (fig. 3); the flow direction forms an angle to the center axis (fig. 3); and the center axis extends substantially parallel with a normal direction of the plan wall portion (fig. 3).

**9. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Barlow '907 or Kahana '214.**

Barlow and Kahana both teach the device of claim 1. Barlow further teaches the device having engaging means (the upper lip or rim) for connection of the device to a cartridge (fig. 3, 4). Kahana further teaches the device having engaging means (42) for connection of the device to a cartridge (fig. 2). Both the upper lip of Barlow and the element (42) of Kahana perform the same function of securing the device to a cartridge in substantially the same way with substantially the same results as the flanges disclosed herein.

**10. Claims 5 and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahana '214 or Barlow '907 of Weber '612.**

Claim 5, Kahana, Barlow and Weber all teach the device of claim 1 as detailed above and the device has sufficient strength to be self supporting but the references do not teach the second extension being significantly shorter than the length of the slit shaped opening in the flow direction. The only difference between the prior art and the claimed invention is a recitation of relative dimension. [W]here the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, *Gardner v. TEC Systems, Inc.*, 220 USPQ 777 (1984).

Claims 7-11, Barlow and Weber all teach the device of claim 1 as detailed above but do not teach the specific dimensions of the second extension. The only difference between the prior art and the claimed invention is a recitation of relative dimension. [W]here the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, *Gardner v. TEC Systems, Inc.*, 220 USPQ 777 (1984).

**11. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahana '214 or Weber '612 or Barlow '907 in view of Correge et al. US 4 421 646, Weis et al. US 3 730 348 and Marks US 3 317 044.**

Kahana, Weber and Barlow teach the device of claim 1 where the slit shaped opening of the filter element has an upstream and downstream end but do not teach the second extension increasing from the upstream end to the downstream end. Changing the cross section of the slit over the length is only a change in the shape of the slit and is very well known in the art as shown in Correge, Weis and Marks. The configuration of the apparatus is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration is significant, *In re Dailey*, 149 USPQ 47 (1966). Also, all the claimed elements, i.e. the shape of the slit, were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention, *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007).

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN KURTZ whose telephone number is (571)272-8211. The examiner can normally be reached on Monday through Friday 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin Kurtz  
Examiner  
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